

**REMARKS**

By the present amendment, Applicant has amended Claim 1, has and cancelled Claims 2-7. Claim 1 remains as the only Claim in the present application.

Initially, Applicant points out that the specification has been amended to correct certain typographical errors. No new matter has been added by this amendment.

In the recent Office Action the Examiner objected to Claim 5, and also rejected Claim 5 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has cancelled Claim 5, and the subject matter found therein, thus obviating both the Examiner's objection for informalities, and rejection for indefiniteness, of Claim 5.

The Examiner objected to Claim 1 as containing informalities. Claim 1 has been amended in accordance with the Examiner's suggestion, thus obviating the Examiner's objection to Claim 1.

In the recent Office Action the Examiner rejected Claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Bonnett (US 5,069,554) in view of Bilotti (US 5,339,748). Claims 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonnett (US 5,069,554) in view of Bilotti (US 5,339,748), and further in view of Petriekis et al. (US 6,609,636).

By the present amendment, Applicant has amended independent Claim 1 by incorporating the subject matter of dependent Claims 2-4, 6 and 7, and has further defined Applicant's invention in a more clear and definite manner. Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

The patent to Bonnett discloses a tablecloth disposal system that includes a flat sheet 1 of flexible, low-density polyethylene film that may take on a circular configuration (Fig. 3). The sheet 1 has a folded, raised edge 2 peripherally surrounding the sheet 1. A cinch strap 3 is formed to slidingly engage the border area 2. Strap 3 is enveloped by a heat-sealed fold 11, which comprises the material of border area 2 folded over and heat sealed to form a seam 10 and tube 9, within which is extended cinch strap 3. But, Bonnett does not show straps or handles having ends that are fixedly attached to the periphery, or border area, by heat welding. The patent to Bilotti shows a table cover 10 for covering a top of a table 11. The table cover comprises a circular panel 12 made of a tough flexible material such as vinyl, cotton, canvas, acrylic or plastic. The panel 12 has a flange 13 along its periphery 40. An elastic band 14 is stitched or otherwise affixed along the outermost peripheral edge 15 of flange 13. The patent to Petriekis et al. discloses a flexible container for a "bag-in-box" packaging system. The system 10 includes a paperboard box 12, and a flexible polymeric bag 14 inserted within the box 12. The flexible polymeric bag is preferably in the form of a

two-ply structure. The Examiner believes that it would have been obvious to have provided an elastic band in the convertible tablecloth of Bonnett as taught by the tablecloth with elastic band of Bilotti, and to form the convertible tablecloth of Bonnett from a two-ply polymeric material as taught by the two-ply, polymeric flexible bag of Petriekis et al. As noted above, the subject matter of original dependent Claims 6 and 7 has been incorporated into amended independent Claim 1. Regarding Claims 6 and 7, the Examiner states: “Bonnett teaches a polymeric strip (plastic drawstring, col. 5, lines 17-18) wherein the end portion is attached to the edge by a heat-welding (heat-sealed fold, col. 4, lines 21-22) (*Office Action, p. 5, lines 1-3*).”

Applicant does not agree with the Examiner’s conclusions. In this regard, the Examiner indicates that Bonnett teaches a polymeric strip or handle attached to the periphery of the flexible, convertible tablecloth. However, the paragraph of Bonnett containing the citation referred to by the Examiner (col. 4, lines 21-22) states:

“Encompassing the upper periphery 5 of the raised border area 2 is cinch strap 3 formed to slidingly engage the border area 2. The cinch 3 is substantially enveloped by a heat-sealed fold 11, which is illustrated in greater detail in FIG. 4. As illustrated in FIG. 4, the heat-sealed fold 1 in the present embodiment comprises the sheet material of border area 2 folded over and heat sealed to form seam 10 and tube 9, within which is extended the cinch strap or piece 3. Each open area 4 may also be sealed at its edges for reinforcement via a seam 12 (Bonnett, col. 4, lines 19-28, emphasis added).”

Applicant notes that FIG. 4 and FIG. 5 in the drawings of Bonnett have been mislabeled (See the Brief Description of the Drawings in col. 3), however, it is clear from the above-cited paragraph in Bonnett that the end of strap, or handle 3 is not fixedly attached by heat welding to the peripheral edge 2. Strap 3 is actually enveloped by a heat-sealed fold 11, which comprises the material of border area 2 folded over and heat sealed to form a seam 10 and tube 9, within which is slidably extended cinch strap 3. The only thing that is heat-welded in Bonnett is border area 2, which is heat welded to itself, thereby forming seam 10 and tube 9. Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The only teaching or suggestion of a strap or handle having attachment ends fixedly attached to the peripheral edge of Bonnett stems from the Applicant's own disclosure. There is no teaching, suggestion or incentive in the applied references which would have led one of ordinary skill in the art to combine the teachings of Bonnett with those of Bilotti and Petriekis et al. to arrive at Applicant's claimed invention, in the manner urged by the Examiner.

MPEP § 2143 states: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” There is nothing in the teachings of the relied upon prior art references which would have suggested the obviousness of the Examiner’s modifications of the tablecloth disposal system of Bonnett. Indeed, some of the modifications are not even shown in the references (e.g. at least two spaced handles comprising a polymeric strip having a pair of attachment end portions and a central grasping portion, each attachment end portion of each said handle being heat welded to said expandable peripheral edge, thereby fixedly attaching said at least two handles to said expandable peripheral edge). It is only by impermissible hindsight and reliance on Applicant’s own disclosure that the Examiner would have been led to reconstruct the tablecloth disposal system of Bonnett so as to derive Applicant’s claimed tablecloth, which is convertible to a garbage bag, from the applied teachings. It is therefore Applicant’s conclusion that the combined teachings of Bonnett, Bilotti and Petriekis et al. fail to establish a *prima facie* case of obviousness.

*Application Serial No.: 10/773,428*  
*Art Unit: 1772*

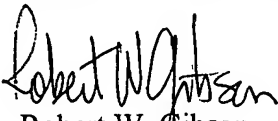
*Attorney Docket No. 21090.00*  
*Confirmation No. 6588*

The prior art references made of record in the present application, but not relied upon by the Examiner in rejecting the claims, have also been carefully reviewed, however, Applicant finds nothing therein which would overcome or supply that which is lacking in the basic combination of the other applied prior art noted above.

The claims in this application have been revised to more particularly define Applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the above-noted reasons is respectfully requested.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

  
Robert W. Gibson  
Litman Law Offices, Ltd.  
Registration No. 57,145  
(703) 486-1000

RWG/dht  
Attachments: Petition for One-Month Extension of Time,  
Check for \$60.00